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Name of applicant, assignee or registered representative

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Signature

March 22, 2007
Date of Signature

PATENT
Case No. AUS920010982US1
(9000/86)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:)	
)	
PHILIP Y. CHANG, ET. AL.)	Examiner: WANG, LIANG
)	
Serial No.: 10/042,480)	
)	Group Art Unit: 2155
Filed: JANUARY 9, 2002)	
)	
Title: AUTOMATION AND DYNAMIC)	Conf. No: 6093
MATCHING OF BUSINESS TO)	
BUSINESS PROCESSES)	

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their appeal brief as follows:

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1. REAL PARTY IN INTEREST

The real party in interest is Assignee INTERNATIONAL BUSINESS
MACHINES CORPORATION, by virtue of an assignment executed by the inventors.

2. RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1-17 stand rejected under the judicially created doctrine of double patenting.

Claims 1-17 stand rejected as anticipated by Albaugh, et. al., United States Patent Publication No. 2003/0115182 ("Albaugh").

Claims 1-17 are the claims on appeal. *See*, Appendix.

4. STATUS OF AMENDMENTS

No amendments have been made or entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In this summary of claimed subject matter, all citations are to the specification of United States Patent Application 10/042,480 filed on January 9, 2002. Further, all citations are illustrative only and support for the cited element may be found elsewhere in the specification.

CLAIM 1

The invention relates to a method of automating the matching of business to business processes including receiving transmission capability from a first company 61 and a second company 62, storing transmission capabilities 63, receiving a request from one of the first and second companies to do business with the other company 64, and determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities 65. See, e.g. FIG. 2 and pages 4 and 5 of the specification, ¶¶13-15 of United States Patent Publication 2003/0131120.

CLAIM 8

The invention relates to a computer usable medium containing computer readable code for automating the matching of business to business processes including computer readable code for receiving transmission capability from a first company 61 and a second company 62, computer readable code for storing transmission capabilities 63, computer readable code for receiving a request from one of the first and second companies to do business with the other company 64, and computer readable code for determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities 65. See, e.g. FIG. 2 and pages 4 and 5 of the specification, ¶¶13-15 of United States Patent Publication 2003/0131120.

CLAIM 15

The invention relates to a system for automating the matching of business to business processes including means for receiving transmission capability from a first company 61 and a second company 62, means for storing transmission capabilities 63,

means for receiving a request from one of the first and second companies to do business with the other company 64, and means for determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities 65. See, e.g. FIG. 2 and pages 4 and 5 of the specification, ¶¶13-15 of United States Patent Publication 2003/0131120.

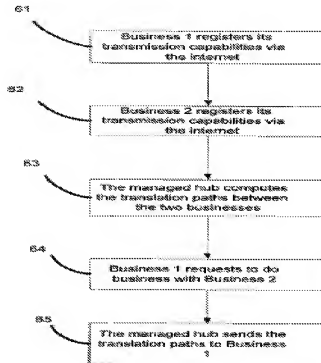


FIG. 2

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-17 were rejected under the judicially created doctrine of double patenting over Albaugh '551.

Claims 1-17 were rejected as anticipated by Albaugh '551.

7. ARGUMENTS

A. Claims 1-17 were provisionally rejected under the judicially created doctrine of double patenting over Application 10/015,234.

The provisional double patenting rejection of claims 1-17 is traversed. Appellants note that Application 10/015,234 issued as United States Patent 6,912,551B2 on June 28, 2005. Appellants will address the rejections based on the '551 patent.

Rejections of claims under the judicially created doctrine of double patenting must be made so as to prevent the unjustified or improper timewise extension of the right to exclude. Such a goal is only attained if the claims are not independent and distinct. See, MPEP §804. A double patenting rejection of this type is analogous to a §103 rejection, and therefore the analysis parallels the guidelines for analysis of a §103 rejection. MPEP §804.

Claims 1-17 are independent and distinct from claims 1-17 of Albaugh '551, as the claims of the '551 patent do not include "transmission capability" as claimed in claims 1, 8, and 15 of the instant application, as well as claims 2-7, 9-14, and 16-17 depending therefrom. A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/ 103(a) does not create a double patenting situation where that subject matter *is not claimed in the reference patent*. See, MPEP §804 ¶III. The instant claims do not claim common subject matter, in contrast to the Examiner's argument of ¶5 of the May 26, 2005 Office Action.

Additionally, for applications pending on or after December 10, 2004 (such as this), rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the reference is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See, MPEP §804 ¶III. Thus, because Albaugh '551 could not be cited in a §103(a) rejection under §103(c), Albaugh '551 should not be cited as an obviousness type double patenting.

In response to the Examiner's statement that there is no apparent reason why Appellants would be prevented from presenting the instant claims in the '551 patent, Appellants note that the '551 patent has issued. See, ¶7 of the November 25, 2005 office action.

Withdrawal of the double patenting rejection is requested.

B. Claims 1-17 were rejected under 35 U.S.C. §102(e) as anticipated by Albaugh '551

The §102(e) rejections of claims 1-17 as anticipated by Albaugh '551 is traversed. In order to sustain the rejection, each and every element of the claimed invention must be disclosed by the reference in at least as great detail as claimed. Since the reference does not disclose each and every element, the rejection should be withdrawn. Appellants note that they are well familiar with the disclosures of Albaugh '551, as they are the named inventors of Albaugh '551 as well as the instant application.

Albaugh '551 does not disclose receiving transmission capability from a first company and a second company and storing transmission capabilities, as claimed in claims 1, 8, and 15. The Examiner's citations to ¶37 (column 4, lines 11-19 of '551) and FIG. 1 of Albaugh '551 are misplaced. That selection discloses only:

[0037] If the initiator and target participant are identified trading partners, decision 330 branches to "Yes" branch 332 whereupon a determination is made as to whether the trading partners have a known transaction process which links, or translates, the initiator's business process to the target participant's process (decision 335). In one embodiment, the target participant's member profile includes the transaction process which links the initiator's business process and the target participant's business process.

The Examiner's allegation that the "business process" is the same as the claimed transmission capability is misplaced. See, ¶¶3a and 10 of the November 25, 2005 office action. While the Examiner correctly notes that information must be received in order to be stored into the member profile, such fact does not disclose that the information being stored is the claimed "transmission capability." It is well settled that the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Without a disclosure of the claimed "transmission capability" or evidence that one of ordinary skill in the art would confuse the same with the disparate "business process" or "transaction process", this anticipation rejection fails.

The Examiner provides no evidence that one of ordinary skill in the art could confuse “business process” or “transaction process” with the claimed transmission capability. Indeed, the disclosure of Albaugh ‘551 indicates that the determination of whether there is a known transaction process linking the initiator and target only occurs if the initiator and target are identified trading partners. Simply substituting the claimed “transmission capability” in the above citation renders the paragraph devoid of meaning.

Furthermore, since the inventive entities of the Albaugh ‘551 reference and the instant application are identical, any unclaimed invention disclosed in Albaugh ‘551 was derived from the inventors of the current application. Therefore, Albaugh ‘551 is not a proper §102(c) reference. See, MPEP §§716.10, 804 ¶III, and *In re Katz*, 687 F.2d 450.

Claims 2-7, 9-14, and 16-17 depend from one of claims 1, 8, or 15 and are therefore patentable over Albaugh ‘551 for at least the same reasons.

Withdrawal of the §102(c) rejections to claims 1-17 is requested.

SUMMARY

The Appellants respectfully submit that claims 1-17 fully satisfy the requirements of 35 U.S.C. §§101, 102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **March 22, 2007**

Respectfully submitted,
PHILIP Y. CHANG, *et al.*

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10. APPENDIX

1. A method of automating the matching of business to business processes comprising:

receiving transmission capability from a first company and a second company;

storing transmission capabilities;

receiving a request from one of the first and second companies to do business with the other company; and

determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities.

2. The method of claim 1 wherein the transmission capabilities represent process formats supported by each company.

3. The method of claim 2 further comprising storing transmission capabilities in a managed hub.

4. The method of claim 1 wherein the translation capabilities represent mapping from one data format to another.

5. The method of claim 4 further comprising storing the translation capabilities in a managed hub.

6. The method of claim 1 wherein the request from one of the first and second companies is regarding any business to business computer transaction.

7. The method of claim 1 wherein the translation path represents a number of data transformation and process translation capabilities.

8. A computer usable medium containing computer readable code for automating the matching of business to business processes comprising:
computer readable code for receiving transmission capability from a first company and a second company;
computer readable code for storing transmission capabilities;
computer readable code for receiving a request from one of the first and second companies to do business with the other company; and
computer readable code for determining a translation path between the first and second companies based on the transmission and translation capabilities.

9. The computer usable medium of claim 8 wherein transmission capabilities represent process formats supported by each company.

10. The computer usable medium of claim 9 further comprising storing transmission capabilities in a managed hub.

11. The computer usable medium of claim 8 wherein the translation capabilities represent mapping from one data format to another.

12. The computer usable medium of claim 11 further comprising storing the translation capabilities in the managed hub.

13. The computer usable medium of claim 8 wherein the request from one of the first and second companies is regarding any business to business computer transaction.

14. The computer usable medium of claim 8 wherein the translation path represents a number of data transformation and process translation capabilities.

15. A system for automating the matching of business to business processes comprising:

- means for receiving transmission capability from a first company and a second company;
- means for storing transmission capabilities;
- means for receiving a request from one of the first and second companies to do business with the other company; and
- means for determining a translation path between the first and second companies based on the transmission and translation capabilities.

16. The system of claim 15 further comprising means for storing the transmission capabilities in a managed hub.

17. The system of claim 15 further comprising means for storing the translation capabilities in a managed hub.

Evidence Appendix

None

Related Proceedings Appendix

None.